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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,169	01/12/2001	Ursula Murschall	00/002 MFE	2792
38263	7590	05/17/2005	EXAMINER	
PROPAT, L.L.C. 425-C SOUTH SHARON AMITY ROAD CHARLOTTE, NC 28211-2841			BERNATZ, KEVIN M	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/760,169

Applicant(s)

MURSCHALL ET AL.

Examiner

Kevin M Bernatz

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-11,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-11,19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendments to claims 1, 8, 9, 19 and 20, filed on March 9 2005, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Examiner's Comments***

3. Regarding the limitation(s) "flame retardant" in claims 1, 19 and 20, the Examiner has given the term(s) the broadest reasonable interpretation(s) consistent with the written description in applicants' specification as it would be interpreted by one of ordinary skill in the art. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Donaldson Co., Inc.*, 16 F.3d 1190, 1192-95, 29 USPQ2d 1845, 1848-50 (Fed. Cir. 1994). See MPEP 2111. Specifically, since applicants are attempting to exclude other "flame retardants", the Examiner deems that it is necessary to clarify on the record what is considered a "flame retardant" versus an additive for a different purpose. Specifically, if a material can be added to the polymer for a reason *other* than flame retardancy, there is a question as to whether it would be excluded by the limitation of a flame retardant "consisting of one or more organic phosphorous compounds". For example, if the UV stabilizer happens to have a secondary effect of improving flame retardancy, would it be excluded? Hence, for the purpose of evaluating

the prior art, the term "flame retardant" has been afforded solely the scope disclosed by applicants' as-filed disclosure (*page 9, last two full paragraphs*) as well as any prior art compounds ***exclusively*** disclosed as flame retardants.

#### ***Request for Continued Examination***

4. The Request for Continued Examination (RCE) under 37 CFR 1.53 (d) filed on March 9, 2005 is acceptable and a RCE has been established. An action on the RCE follows.

#### ***Claim Rejections - 35 USC § 103***

5. Claims 1, 2 and 4 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murschall et al. (DE 196-30-599 A1) in view of Zannuchi et al. (U.S. Patent No. 4,265,804) and Oishi et al. (U.S. Patent No. 5,936,048) for the reasons of record as set forth in Paragraph No.'s 3 – 6 of the Office Action mailed on November 26, 2004.

Regarding the amended language of claim 1 to recite that the at least one flame retardant *consists* of one or more organic phosphorous compounds, the Examiner notes that Oishi et al. teaches that it is known in the art that flame retardants consisting of organic phosphorous compounds can be utilized to achieve flame retardancy as well as the ability to maintain the physical properties of the resin (*col. 3, lines 29 – 41 and col. 4, lines 9 – 17*). Furthermore, the Examiner notes that the additional epoxy-modified resins of Oishi et al. are *not* excluded by the claimed limitations since these compounds are explicitly noted that they can be added for other than flame retardancy, hence still

being permissible in applicants "oriented film" (*Oishi et al.*, col. 3, lines 1 – 27). See Paragraph 3, above, for the scope afforded the limitation "said flame retardant(s) consisting of one or more organic phosphorous compounds".

Regarding the amended language of claim 20, the Examiner notes that the *Oishi et al.* disclose identical organic phosphorous flame retardants as disclosed by applicants, hence clearly meeting the limitation of "compounds(s) that are soluble within said thermoplastic". While *Oishi et al.* fail to explicitly teach controlling the amount of flame retardancy to meet the requirements of UL class 94 VTM-0, the Examiner deems that such a degree of flame retardancy would have been both within the knowledge of one of ordinary skill in the art since it is a recognized flame retardancy test (see *applicants' specification*, page 3, last paragraph) and would have been obvious to obtain depending on the desired end use of the film, since one of ordinary skill in the art would have readily appreciated that films being used in potential flame hazard locations should meet the highest level of flame retardancy. Finally, the Examiner notes that *Oishi et al.* explicitly disclose meeting such a requirement (*e.g. Table 3*).

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murschall et al. in view of Zannuchi et al. and *Oishi et al.* as applied above, and further in view of Rakos et al. (U.S. Patent No. 6,251,505) for the reasons of record as set forth in Paragraph No.'s 7 – 8 of the Office Action mailed on November 26, 2004.

7. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murschall et al. in view of Zannuchi et al. and Oishi et al. as applied above, and further in view of Schreck et al. (U.S. Patent No. 5,866,246) and Kishida et al. (U.S. Patent No. 5,008,313) for the reasons of record as set forth in Paragraph No.'s 9 - 10 of the Office Action mailed on November 26, 2004.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murschall et al. in view of Zannuchi et al., Oishi et al. Schreck et al. and Kishida et al. as applied above, and further in view of Ragan et al. (U.S. Patent No. 4,551,485) for the reasons of record as set forth in Paragraph No.'s 11 – 12 of the Office Action mailed on November 26, 2004.

### ***Response to Arguments***

9. **The rejection of claims 1 – 6, 8 – 11, 19 and 20 under 35 U.S.C § 103(a) – Murschall et al. in view of various references**

The Examiner notes that applicants' arguments were presented in the after-final amendment filed February 15, 2005, which were addressed in the advisory action mailed February 22, 2005. To briefly reiterate, the Examiner notes the following:

Regarding applicants' argument that Oishi et al. (US '048) fail to teach flame retardants consisting of organic phosphorous compounds, the Examiner notes that this has been addressed in the pending rejection of record. See also Paragraph 3, above.

Regarding applicants' argument that Rakos et al. (US '505) teach a translucent film versus a transparent film, the Examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, applicant(s) are reminded that "the test for obviousness is not whether features of the secondary reference may be bodily incorporated into the primary reference's structure, nor whether the claimed invention is expressly suggested in any one or all of the references, rather the test is what the combined teachings would have suggested to those of ordinary skill in the art." *Ex parte Martin* 215 USPQ 543, 544 (PO BdPatApp 1981). In the instant case, transparency is taught by the base reference and Rakos et al. is merely relied upon to teach that the knowledge of adhesive bonding layers are known in the laminate art. The Examiner deems that such adhesive bonding layers are clearly applicable to either transparent or translucent films.

Applicants have presented similar arguments, attacking Schreck et al. (US '246) and Kishida et al. (US '313) individually. As per above, the Examiner notes that the rejection is predicated on the combination of several references and the Schreck et al. and Kishida et al. references are merely relied upon to show the level of ordinary skill in the art with regard to what compounds are known stabilizers, given that the base rejection provides explicit teaching to use a hydrolysis stabilizer. At no point did the Examiner suggest bodily incorporating the entire subject matter of either Schreck et al. or Kishida et al. into the structure disclosed by the base rejection.

Similar arguments are presented for the rejection utilizing Ragan et al. (US '485), which the Examiner notes are unpersuasive for substantially the same reasoning as applied above.

### **Conclusion**

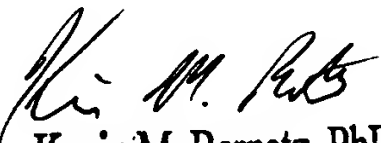
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin M. Bernatz, PhD.  
Primary Examiner

May 13, 2005

  
Kevin M. Bernatz, PhD  
Primary Examiner